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U. S. DISTRICT COURT
DISTRICT OF COLUMBIA
UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

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ELF ATOCHEM NORTH AMERICA, INC.)
Plaintiff,) NANCY M.
v.) MAYER-WHITTINGTON
Q. TODD DICKINSON,) CLERK
Director of the United States Patent)
and Trademark Office,)
Defendant.) Civil Action No. 99-2559 (TPJ)

**DEFENDANT'S REPLY IN SUPPORT
OF HIS MOTION FOR SUMMARY JUDGMENT**

Atochem has not presented a good explanation of why it should be entitled to present new evidence to this Court. Nor has Atochem raised any genuine issue of material fact with respect to the evidence it presented to the PTO below. Accordingly, the Director is entitled to summary judgment.

L ATOCHEM'S NEW EVIDENCE SHOULD NOT BE CONSIDERED**A. A Section 145 Plaintiff Cannot Present New Evidence Without a Good Explanation of Why It Could Not Present the Evidence Below**

The District of Columbia Circuit and this Court have long recognized that a section 145 plaintiff -- like plaintiffs seeking administrative review of decisions from other federal agencies -- does not have an unfettered right to present new evidence to this Court that it failed to present below. Instead, the plaintiff must put forward some reason of justice explaining its failure to present the evidence during administrative proceedings before the PTO. See DeSeversky v.

* Effective March 29, 2000, the Commissioner of Patents and Trademarks is now known as the Director of the Patent and Trademark Office. See Helfgott v. Karas, 209 F.3d 1328, 1329 n.1 (Fed. Cir. 2000).

Brenner, 424 F.2d 857, 858-59 & n.5 (D.C. Cir. 1970). This Court has repeatedly refused to consider new evidence when the plaintiff did not have a good explanation for why it could not present the evidence to the PTO first. See, e.g., Holloway v. Quigg, 9 U.S.P.Q.2d 1751, 1752 (D.D.C. 1988); MacKay v. Quigg, 641 F. Supp. 567, 570-71 (D.D.C. 1986); Killian v. Watson, 121 USPQ 507, 508 (D.D.C. 1958); see also Monsanto Co. v. Kamp, 269 F. Supp. 818, 822 (D.D.C. 1967).

This reasonable limitation on a plaintiff's ability to present new evidence is necessary for the administrative process to work as intended. Patent evidence should be presented first to the PTO and its scientifically-trained examiners "since the application of Patent Office expertise in the first instance may either obviate the need for judicial consideration, or illuminate the issues and facilitate the court's disposition." DeSeversky, 424 F.2d at 859. When the PTO has had an opportunity to first review the evidence and present its findings, that allows this Court to rely not only on this Court's expertise in reviewing administrative determinations of all kinds, but also on the technical expertise which is the special province of the PTO. Thus, this Court has recognized that the policy of encouraging full administrative disclosure is a "compelling" reason "to fashion limitations on the admissibility of supplementary evidence" in section 145 actions. MacKay, 641 F. Supp. at 570. See also California Res. Corp. v. Ladd, 356 F.2d 813, 820-21 n.18 (D.C. Cir. 1966) ("the District Court proceeding may not be conducted in disregard of the general policy of encouraging full disclosure to administrative tribunals").

Atochem now asserts that the establishment of the Federal Circuit led to a change in the law, under which the Federal Circuit has rejected any requirement that a section 145 plaintiff justify why it is entitled to present new evidence. See Pl.'s Opp. at 12-13. This is not correct.

Even after the establishment of the Federal Circuit in 1982 and the accompanying transfer of appellate jurisdiction over this Court's patent cases from the District of Columbia Circuit to the Federal Circuit, see 28 U.S.C. § 1295(a)(4)(C), and even after the Federal Circuit decided many of the cases on which Atochem attempts to rely, this Court has continued to hold that a plaintiff without a good explanation is not entitled to present new evidence. See Holloway, 9 U.S.P.Q.2d at 1752 (decided in 1988); MacKay, 641 F. Supp. at 570-71 (decided in 1986). This accords with the Federal Circuit's own express recognition that a section 145 plaintiff "does not start over to prosecute his application before the district court unfettered by what happened in the PTO."

Fregeau v. Mossinghoff, 776 F.2d 1034, 1038 (Fed. Cir. 1985).

The case Atochem cites for its alleged power to introduce new evidence without explanation is Case v. CPC International, Inc., 730 F.3d 745 (Fed. Cir. 1984). See Pl.'s Opp. at 12-13. But Case expressly states that it is not deciding the issue: "Whether under some circumstances a district court may properly restrict the admission of testimony on an issue raised before the board is not before us." 730 F.2d at 752 (emphasis added).

Atochem's reliance on Case and the other decisions it propounds on pages 12 and 13 of its opposition -- Winner International Royalty Corp. v. Wang, 202 F.3d 1340 (Fed. Cir. 2000), and Estee Lauder, Inc. v. L'Oreal, S.A., 129 F.3d 588 (Fed. Cir. 1997) -- is further misplaced because all of those decisions involve review of decisions involving patent interferences under 35 U.S.C. § 146, not review of patentability decisions under section 145. See Case, 730 F.2d at 747; Winner, 202 F.3d at 1345; Estee Lauder, 129 F.3d at 592. While some of the terms delineated in sections 145 and 146 are similar, their treatment of new evidence is not. Section 146 expressly refers to "the right of the parties to take further testimony." But section 145 has no such

provision and is instead silent. If Congress intended to create a "right" to take further testimony in section 145 cases, it could have said so as it did in section 146, which implies that Congress did not intend a section 145 plaintiff to have an unfettered right to present new evidence under any circumstances.

The other decisions Atochem cites on page 11 of its opposition -- Gould v. Quigg, 822 F.2d 1074 (Fed. Cir. 1987), and Burlington Industries, Inc. v. Quigg, 822 F.2d 1581 (Fed. Cir. 1987) -- are no more helpful to its cause. Gould, like Fregeau, states that "the parties are entitled to submit additional evidence." Gould, 822 F.2d at 1076; Fregeau, 776 F.2d at 1037. Burlington states that the evidence before the district court "may" include new evidence. Burlington, 822 F.2d at 1584. But the Federal Circuit did not say that the plaintiff has an unlimited right to present new evidence. To the contrary, the Federal Circuit has held that even in a section 146 case "the right to offer new evidence is not unlimited." Conservolite, Inc. v. Widmayer, 21 F.3d 1098, 1102 (Fed. Cir. 1994) (emphasis added). "A proceeding under § 146 is not a chance for a party to reconstruct its case, based on a new litigation strategy, leapfrogging the administrative process in the PTO." Id. at 1103. In view of the differences between section 145 and section 146, Atochem is even less entitled to use this section 145 action to reconstruct its patentability case using evidence that it could have presented to the PTO first.

B. Atochem Has Not Provided a Good Explanation of Why It Could Not Have Presented Its New Evidence to the PTO

There is a tremendous disconnect between the new evidence which Atochem attaches to its summary judgment opposition and the reasons why Atochem claims it is entitled to rely on this new evidence. The new evidence Atochem attaches consists of two new declarations executed in

May 2000. See Pl.'s Opp. at 1 & Exs. A-B. But Atochem does not even attempt to explain why it could not have prepared those declarations in time to present them during administrative proceedings before the PTO first. Instead, Atochem asserts that it is entitled to rely on new evidence because live testimony will be helpful to the Court. See Pl.'s Opp. at 11-12 n.8. With all respect to Atochem, this non sequitur begs the question.

The Director agrees that live testimony can be helpful to a Court who needs to, in Atochem's words, "observe demeanor, hear witnesses rebut one another's testimony, and determine credibility." Pl.'s Opp. at 11-12 n.8. The Director also recognizes that if this Court should ultimately allow Atochem to present new evidence such as that presented in the declarations attached to Atochem's opposition, and it therefore becomes necessary for the Director to take discovery and develop new evidence of his own, this Court may ultimately determine that live evidence would be helpful in resolving any resulting evidentiary disputes. But that assumes that Atochem is entitled to present new evidence. And Atochem has not even attempted to explain why it could not have presented its new evidence to the PTO first.

There is certainly no reason to suppose that Atochem could not have presented the evidence in its new declarations to the PTO first. The declarations include test results that are similar to those included in the 1982 Foure declaration and discuss the same Gough and Stapfer prior art references. Compare Pl.'s Opp. Exs. A-B (new declarations) with Def.'s Ex. 14 (1982 declaration); see also Def.'s Exs. 3-4 (Gough and Stapfer references). The new declarations do not suggest that they are based on testing methodologies or materials that differ in any way from those previously available. See Pl.'s Opp. Exs. A-B.

Moreover, Atochem's "statement of genuine issues" suggests that the real reason why Atochem did not present the evidence earlier is not because it could not, but rather because it chose not to do so:

[In its appeal brief before the Board of Patent Appeals and Interferences,] Atochem, on pages 34-35, referred the Board to an example in the specification [of Atochem's patent application] and the 1982 Declaration as evidence of unexpected results. Those arguments and that data should have, in Atochem's opinion, overcome the obviousness rejection. Because the Board refused to reverse the Examiner, Atochem now takes the opportunity in this action under 35 U.S.C. § 145 to submit additional evidence in support of its arguments to overcome the sole remaining rejection.

Pl. Atochem's Statement of Genuine Issues ¶ 32 (emphasis added). This is tantamount to an admission that Atochem made a judgment call that it did not need to present additional evidence to prevail before the PTO. Atochem's judgment call was wrong. But that does not entitle Atochem to a second bite of the apple, any more than it would entitle any other disappointed litigant who wishes after the fact that it had presented more evidence to support its position. Had Atochem timely filed its new declarations with the PTO, the patent examiner and Board would have been able to apply their special expertise to "either obviate the need for judicial consideration, or illuminate the issues and facilitate the court's disposition." DeSeversky, 424 F.2d at 858-59. To allow Atochem to present the new evidence now would only encourage more patent applicants to burden this Court with more section 145 actions based on new technical evidence that this Court will have to consider in the first instance without the benefit of prior PTO review.

Atochem's assertion that it needs to present live testimony in this action is also contradicted by its failure to even contend that live testimony is needed before this Court resolves

this summary judgment motion. The burden was on Atochem to come forward with any arguments and evidence it has to defeat summary judgment. See Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986). And under Fed. R. Civ. P. 56(f), if Atochem believed that it needs live testimony to defeat summary judgment, it was required to present an affidavit (or declaration) explaining the reasons why that is the case. Atochem failed to present any such affidavit. Moreover, while Atochem asked for a hearing on the present motion, Atochem did not ask for leave to present any live testimony at that hearing. Accordingly, Atochem should be considered to have abandoned any argument it might have had for avoiding summary judgment on the basis of live testimony.

The most Atochem might arguably be entitled to on the basis of its arguments is an opportunity to present live testimony discussing the evidence which Atochem already presented to the PTO, namely its patent application and the 1982 Foure declaration. Even in this limited arena, however, Atochem's argument does not stand up. Atochem says that it wants live testimony so the Court can assess credibility. See Pl.'s Opp. at 11-12 n.8. But neither the Board nor the examiner questioned the credibility of Atochem's application or declaration evidence. Of course, if this Court decides to allow Atochem to present new evidence or any sort of live testimony, the Director reserves the right to question the credibility of any evidence presented by Atochem, new or old, at that time. But at present, there are no credibility issues. Accordingly, to the extent this case is limited to a review of the administrative record before the PTO -- and Atochem has not shown that it is entitled to anything more -- live testimony will be no more helpful to the Court than in any other type of administrative review case.

C. Atochem Does Not Dispute That It Had Ample Opportunities to Present Additional Evidence to the PTO

Atochem's opposition is also striking for its failure to contest the Director's recitation of the many avenues Atochem could have taken to present additional evidence to the PTO first. Atochem could have presented additional evidence at any time during the 15 years between the filing of its original application in 1979 and the filing of its appeal to the Board in 1994. See Def.'s Mem. at 28. Even after Atochem appealed to the Board, it was still free to present new evidence in connection with the present application, or by filing a new "continuation" application. See id. In fact, Atochem did file a continuation in 1995, but Atochem later abandoned it. See id. at 29. See also id. at 2-3, 28-29 (explaining why the 1995 change in the patent term statute does not excuse Atochem's failure to present additional evidence to the PTO). Atochem's silence in the face of these arguments suggests that Atochem itself acknowledges that there was far more that it could have done, and should have done, at the administrative stage. Atochem should not be allowed to present new evidence now when it had so many opportunities to present it below.

D. If This Court Should Determine to Allow Atochem to Present Live Testimony, It Should Limit That Testimony to Discussion of the Evidence Presented During the Administrative Proceedings Before the PTO

At the March 6, 2000 status conference, this Court indicated that it sometimes finds live testimony helpful in resolving patent cases. The Director submits that live testimony would not be helpful in the present case because, as explained above, Atochem has not shown that it is entitled to rely upon new evidence, and the PTO has not questioned the credibility of the existing evidence. Because this Court does not need to make credibility determinations, the course which appears most consistent with judicial economy is to decide this action without live testimony.

If this Court should nevertheless determine that live testimony would be of assistance, the Director respectfully requests that the testimony be limited to discussion of the evidence presented during the administrative proceedings before the PTO, since Atochem has not explained why it should be allowed to present any new evidence through live testimony or otherwise. The Director also respectfully requests that he receive a reasonable opportunity to depose Atochem's proposed witnesses first, and reserves the right to question the credibility of those witnesses.

II. THE RECORD SUPPORTS THE PTO'S DETERMINATION

The following argument is based on the record evidence Atochem presented to the PTO, not the new evidence in the declarations attached to Atochem's opposition, because Atochem has not shown that it is entitled to present the new evidence to this Court. Should this Court determine to allow Atochem to rely on any new evidence, then the Director reserves the right to respond to it at that time. The Director's counsel had asked Atochem to proffer its new evidence before he filed the present motion, in the hope that review of the evidence would allow the parties to narrow the issues, but Atochem declined to do so. Accordingly, the first notice the Director received of the new evidence was when Atochem filed its opposition to the present motion. It would be unfair and unreasonable to expect the Director to respond to this newly-presented evidence without discovery and a reasonable opportunity for the Director to develop new evidence of his own.

A. The Substantial Evidence Standard Applies Because Atochem Is Not Entitled to Present Any New Evidence

Atochem's standard of review argument relies on Atochem's assumption that it will be allowed to present new evidence. See Pl.'s Opp. at 13 (arguing that "the introduction of new or

different evidence . . . triggers a de novo trial"). But as explained above, Atochem has not shown that it should be allowed to present new evidence. And because Atochem cannot present new evidence, the Federal Circuit's caselaw -- including cases on which Atochem relies in its opposition -- expressly provides for deferential review. See, e.g., Burlington, 822 F.2d at 1584 ("The underlying facts are reviewed for clear error in their finding, and when additional evidence is adduced beyond that before the PTO the factual weight must be determined afresh."); Fregeau, 776 F.2d at 1038 ("in the absence of additional evidence . . . a finding of fact by the board may be set aside by the district court if clearly erroneous"). Indeed, this is fully consistent with Atochem's recognition that a more deferential standard is appropriate when the only basis for review is the agency record. See Pl.'s Opp. at 15-16.

More recently, the Federal Circuit has clarified that the proper standard of review for the PTO's factual determinations is substantial evidence, not clear error. See In re Gartside, 203 F.3d 1305, 1308 (Fed. Cir. 2000). Atochem is correct on page 15 of its opposition that Gartside was a direct appeal to the Federal Circuit, but that does not diminish its applicability to this action. In Gartside, the Federal Circuit recognized that the Supreme Court's decision in Dickinson v. Zurko, 527 U.S. 150 (1999), required it to implement an APA standard of review of PTO decisions. Gartside, 203 F.3d at 1311. The Federal Circuit determined that substantial evidence is the appropriate standard. Id. at 1312-15. There is nothing in Gartside to suggest that the APA standard would not also apply to cases like the present one in which this Court is performing a record review of a PTO decision.

B. Atochem's Claimed Composition Is Unpatentably Obvious

As fully explained in the Director's opening memorandum, Atochem's claimed invention (Compound A + B; and Compound A' + B) is obvious over the prior art because there is no difference between what the prior art would have suggested to a person of ordinary skill in the art and Atochem's broadly claimed compositions. Def.'s Mem. at 12-25.

The vast majority of Atochem's arguments in opposition are based on the new evidence in the declarations attached to its opposition. See Pl.'s Opp. at 19-37 (repeatedly referring to "Foure" and "Bertelo"); Pl.'s Opp. at 1, 5 & Exs. A-B ("Foure" and "Bertelo" are the May 2000 declarations attached as Exhibits A and B to Atochem's opposition). Indeed, when Atochem asserted in the Preliminary Statement of its opposition that there are genuine issues of material fact, Atochem referred only to the new declarations -- not the evidence presented to the PTO -- as raising the allegedly genuine issues. See Pl.'s Opp. at 4. But as explained above, the new evidence should not be considered. Accordingly, the few arguments based on the existing record are addressed below.

1. Substantial Evidence Supports the Board's Findings that the Prior Art Teaches Each Compound of the Claimed Composition**a. Gough**

Atochem attacks Gough as being a "useless invention that persons of ordinary skill in the art would have immediately ignored." Pl.'s Opp. at 20. Atochem offers no citation in support of its assertion, but Atochem apparently intends to refer to statements in the new *Foure* declaration discussed on pages 22 and 23 of the opposition. Because this attack on Gough is based solely on Atochem's new evidence, it should not be considered, and this Court should ignore Atochem's

attempt to discredit Gough as a legitimate prior art reference. See DeSeversky, 424 F.2d at 858-

59. Moreover, it is notable that Dr. Foure did not make this assertion when he completed his declaration in 1982. See Def.'s Ex. 14 (1982 Foure declaration). If Gough truly were "useless" and something practitioners of the art would have "immediately" ignored, surely Dr. Foure would have been aware of that in 1982.

The relevance of Gough is supported by Atochem's own admission that Gough discloses Compound B, which Atochem refers to as a "reverse ester." Pl.'s Opp. at 21; see Pl.'s Opp. at 6 n.3 ("reverse ester" means Compound B). Atochem attempts to downplay this direct disclosure and argues that Compound B is "only one of 29 chemicals listed" as thiols. Pl.'s Opp. at 21. But a prior art reference "must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to patent." See EWP Corp. v. Reliance Univ. Inc., 755 F.2d 898, 907 (Fed. Cir. 1985). What matters is that the disclosure was in the prior art before Atochem filed its patent application. Therefore, Atochem's attempts to trivialize the direct teaching of Compound B by Gough must fail.

Atochem also tries to dispose of Gough by arguing that it teaches away from the claimed invention. Pl.'s Opp. at 24-27. As Atochem recognizes, teaching away is a question of fact. See Pl.'s Opp. at 25 n.17. The Board found that Atochem's claims would have been obvious in view of Gough and the other references, and thus necessarily found that Gough does not teach away. See Def.'s Ex. 1 at 13-14. This factual determination must be upheld if it is supported by substantial evidence.

The record shows that while Gough does not teach the specific organotin compounds A and A' recited in Atochem's patent claims, Atochem has admitted that Compounds A and A'

were well known in the art. See Def.'s Mem. at 14 (providing record citations). Moreover, Gough teaches the combination of Compound B with other organotin compounds, namely organotin borates. See id. This suggests that, if anything, Gough teaches toward Atochem's claims.

Atochem is correct that at one point the PTO examiner stated that Gough taught away from the invention. See Pl.'s Opp. at 24-25. But that was not the examiner's final decision on the issue. As Atochem recognizes, after further consideration the examiner determined that Gough should be applied. See Pl.'s Opp. at 25 n.17. The Board then affirmed the examiner's determination that the claims would have been obvious over Gough. See Def.'s Ex. 1 at 16. Contrary to Atochem's assertion, this does not raise a fact issue, and it certainly does not provide an excuse for Atochem to present new evidence. "There is nothing unusual, certainly, about an examiner changing his viewpoint as to the patentability of claims as the prosecution of a case progresses, and, so long as the rules of Patent Office practice are duly complied with, an applicant has no legal ground for complaint because of such change in view." In re Ruschig, 379 F.2d 990, 993 (CCPA 1967)*; see also In re Morris, 127 F.3d 1048, 1056-57 (Fed. Cir. 1997) (examiner can renew previous rejections during prosecution and applicant must address renewed rejections).

b. **Stapfer**

In the limited portion of its argument that does not rely on the new evidence attached to Atochem's opposition which should not be considered, Atochem attempts to downplay the significance of Stapfer by arguing that its focus is not on stabilizers but on a substrate used to

* The CCPA, or Court of Customs and Patent Appeals, was a predecessor Court to the Federal Circuit whose decisions are treated as precedential by the Federal Circuit. See South Corp. v. United States, 690 F.2d 1368, 1370 (Fed. Cir. 1982) (in banc).

enhance the performance of the stabilizers. Pl.'s Opp. at 27. But Stapfer teaches both, and the Director is entitled to rely upon its teaching of stabilizers. See EWP, 755 F.2d at 907. Stapfer teaches that Atochem's claimed organotin sulfides (Compound A) are well-known stabilizers in the PVC art. See Def.'s Mem. at 15 (providing record citations). Atochem admits that these compounds are well-known stabilizers. See Pl.'s Opp. at 33.

Stapfer also specifically teaches combining various compounds to make an improved stabilizer composition, which is exactly what Atochem is claiming. See Def.'s Mem. at 15-16 (providing record citations). Atochem's arguments about the number of stabilizers taught by Stapfer, see Opp. at 27-28, cannot dilute the fact that it teaches part of Atochem's claimed composition and that it provides motivation to combine that part with other stabilizers such as the one disclosed by Gough and claimed by Atochem. See Def.'s Mem. at 24. Again, there is no genuine fact issue.

c. The Other References

The Director's opening memorandum explained that the remaining prior art references relied upon by the Board apply because they teach Atochem's Compound A or A' or both. Def.'s Mem. at 15-18. Atochem does not contest these facts. See Pl.'s Opp. at 31-32.

2. There Is Substantial Evidence to Support the Board's Finding that the Prior Art Contained a Motivation to Combine

Atochem admits that each of the pieces of the claimed invention (Compounds A, A', and B) can be found in the prior art. See Pl.'s Opp. at 21, 27, 31. Accordingly, the only remaining issue with respect to the prima facie obviousness of Atochem's patent claims is whether there is a motivation, suggestion, or reason to combine the references to render the claims obvious. See

Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997).

Atochem claims there is none, but the Board found otherwise. As the Federal Circuit has stated unequivocally, motivation is a pure question of fact. Gartside, 203 F.3d at 1316. Therefore, the Board's finding of motivation in this case can only be reversed if not supported by substantial evidence. See id. at 1315. Atochem has not met its burden of proving that the Board's decision lacked substantial evidence.

As explained in the Director's opening memorandum, there is motivation to combine if the cited references are addressed to the same problem. See Def.'s Mem. at 23 (citing In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (motivation may come from the nature of the problem to be solved)). All of the references in this action are addressed to the same problem of stabilizing PVC. See Def.'s Mem. at 23. This in itself is a sufficient basis to affirm the Board. See Dembiczak, 175 F.3d at 999. Significantly, Atochem does not even attempt to rebut that all of the references are addressed to the same problem and that this provides motivation to combine. See Pl.'s Opp. at 32-33.

Instead, Atochem attempts to attack each reference as not providing a motivation to combine. See Pl.'s Opp. at 32-33. To the contrary, the Director's opening memorandum summarizes the detailed evidence in the references in support of the Board's finding. See Def.'s Mem. at 23-25. The only evidence Atochem attempts to offer in response is new evidence which should not be considered. See Pl.'s Opp. at 32. Atochem has failed to raise a genuine issue concerning motivation to combine.

3. There Is Substantial Evidence to Support the Board's Finding that Atochem's Evidence of Nonobviousness Was Inadequate

The only evidence of nonobviousness which Atochem provided to the Board was contained in the patent application itself and the 1982 Foure declaration. Atochem's present argument is based primarily on new evidence which it did not present to the PTO, see Pl.'s Opp. at 33-37, and to that extent should not be considered. And even to the extent that Atochem attempts to argue on the basis of the evidence which Atochem did present to the PTO, it fails to show reversible error in the Board's determination, or even to raise a genuine issue of fact.

Contrary to Atochem's assertion on page 34 of its opposition, the patent specification (part of the application) does not provide any relevant evidence of unexpected superiority of Atochem's claimed invention. Example XIV, on which Atochem relies, does not provide the necessary comparison with the closest prior art. See In re Baxter Travenol Labs., 952 F.2d 388, 392 (Fed. Cir. 1991) ("when unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art"). Atochem's opposition makes only summary assertions concerning comparison of Atochem's reverse ester -- Compound B -- and two different compounds taught by Gough. See Pl.'s Opp. at 34. But Atochem has admitted that Gough also teaches Compound B. See Pl.'s Opp. at 6, 21. It follows that Atochem's Example XIV did not compare to the closest compound taught by Gough. Accordingly, Example XIV did not compare to the closest prior art.

Atochem also reargues the applicability of the 1982 Foure declaration, but Atochem relies on its new evidence to supplement it. See Pl.'s Opp. at 34-36. Stripped of this inadmissible bolstering, Atochem's argument concerning the 1982 Foure declaration must fail because the

1982 declaration does not make any comparison to the closest prior art. See Def.'s Mem. at 26 (providing record citations). Atochem admits that the 1982 declaration did not compare its claimed composition with Gough, see Pl. Atochem's Statement of Genuine Issues ¶ 35, and its only response is to point to tests it has belatedly run, apparently in response to the present motion, which allegedly provide the necessary comparisons. See Pl.'s Opp. at 36-37 & Ex. B. But it is now far too late for Atochem to present new evidence that it could have presented years ago.

Finally, there is no genuine issue with respect to the Board's finding that the 1982 Foure declaration is not commensurate in scope with the degree of protection Atochem seeks in its patent claims. See Def.'s Mem. at 26; In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983). Atochem asserts that the declaration provided 50 combinations of compounds. Pl. Atochem's Statement of Genuine Issues ¶ 36. But Atochem does not dispute that only five of these combinations fall within Atochem's claims. See Mem. at 26; Def.'s Ex. 14 ¶ 4. And the new data Atochem seeks to add, see Pl. Atochem's Statement of Genuine Issues ¶¶ 36-37, is not properly before this Court. The data in the 1982 Foure declaration covers such a small fraction of the claimed compositions that there is no adequate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition. See Mem. at 26; In re Lindner, 457 F.2d 506, 509 (CCPA 1972). The narrow evidence of nonobviousness proffered by the 1982 Foure declaration is inconclusive, and plainly is not sufficient to support the patentability of Atochem's claims.

CONCLUSION

Atochem should have and could have presented its new evidence during the administrative proceedings before the PTO in the first instance. Because it failed to do so, and has failed to

provide a good explanation for its failure, Atochem should not be permitted to present the new evidence to this Court. Instead, this action should be decided on the basis of the administrative record. Moreover, because substantial evidence supports the Board's determination that Atochem's claimed invention is unpatentable, this Court should affirm the Board's decision, enter judgment in favor of the Director, and dismiss this action.

Respectfully submitted,

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June 9, 2000

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on June 9, 2000, I served a copy of the foregoing Defendant's Reply in Support of Its Motion for Summary Judgment by overnight delivery on the following:

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